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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,670	07/23/2001	Andrew W. Taylor	ERI-114AX	6394

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BOSTON, MA 02109

EXAMINER

EWOLDT, GERALD R

ART UNIT	PAPER NUMBER
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1644

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/912,670

**Applicant(s)**

TAYLOR ET AL.

**Examiner**

G. R. Ewoldt, Ph.D.

**Art Unit**

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24,42 and 43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24,42 and 43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Claims 1-23 and 25-41 have been canceled.

Claim 24 and newly added Claims 42 and 43 read on the elected invention and are being acted upon.

2. Applicant's amendments and remarks, filed 7/12/04, are acknowledged.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 24 and newly added Claim 42 stands/is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,048,850 in view of Lipton et al. (1997, IDS) for the reasons of record set forth in the action mailed 2/10/04.

Applicant's arguments, filed 7/12/04, have been fully considered but they are not persuasive. Applicant argues, that arthritis is not a T cell-mediated disease and that the Examiner has incorrectly characterized the Lipton et al. reference.

Applicant is advised that a search of PubMed (<http://www.ncbi.nlm.nih.gov/entrez/query.fcgi>), Titles and Abstracts alone, generates 170 hits, the majority of which indicate that arthritis is indeed a T cell-mediated disease. Regarding Lipton et al., the reference teaches that  $\alpha$ -MSH has an inhibitory effect on the chronic inflammation of induced arthritis and inflammatory bowel disease, i.e., T cell-mediated conditions (page 141, column 2, Box I). Accordingly, it remains the Examiner's position that the method of the instant claims is obvious in view of the prior art.

5. The following are new grounds for rejection necessitated by Applicant's amendment.

6. Claim 43 is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,048,850 in view of Lipton et

al. (1997, IDS), as applied to Claims 24 and 42 above, and in further view of Singh et al. (1996).

U.S. Patent No. 6,048,850 and Lipton et al. have been discussed above. The references differ from the claimed invention in that they do not teach the use of  $\alpha$ -MSH for the treatment of a disease wherein the autoimmune-diseased tissue site is an eye of an animal.

Singh et al. teaches that uveitis is a T cell-mediated disease that is the major cause of visual impairment in humans (see particularly the Abstract).

It would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to perform the method of the '850 patent, employing  $\alpha$ -MSH as the anti-inflammatory compound, as taught by Lipton et al., for the treatment of autoimmune-diseased tissue of the eye of an animal. One of ordinary skill in the art at the time the invention was made would have been motivated to treat uveitis (a T cell-mediated autoimmune disease of the eye tissue) given the teachings of Singh et al. that uveitis is the major cause of visual impairment in humans; accordingly, effective treatments would be desirable.

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 42 and 43 are rejected under 35 U.S.C. § 112, first paragraph, as the specification does not contain a written description of the claimed invention, in that the disclosure does not reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time the application was filed. This is a new matter rejection.

The specification and the claims as originally filed do not provide support for the invention as now claimed, specifically:

A) The method of claim 24, wherein the animal is a human, a mouse, a rat, a dog, a cat, a rabbit or a horse (Claim 42).

B) The method of claim 24, wherein the autoimmune-diseased tissue site is an eye of the animal (Claim 43).

Applicant indicates that no new matter had been added, however, no support has been identified in the specification and none has been found.

9. No claim is allowed.

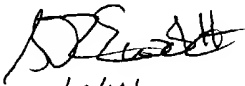
10. Applicant's amendment or action necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Gerald Ewoldt whose telephone number is (571) 272-0843. The examiner can normally be reached Monday through Thursday from 7:30 am to 5:30 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (571) 272-0841.

12. **Please Note:** Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see [www.uspto.gov/ebc/newusers.html](http://www.uspto.gov/ebc/newusers.html). Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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9/3/04  
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